

Remarks

The Office Action dated May 19, 2010 notes the following new grounds of rejection: claims 1-4 and 24 stand rejected under 35 U.S.C. § 103(a) over Vilppula *et al.* (U.S. Patent Pub. 2002/0019698) in view of Yamamoto *et al.* (U.S. Patent Pub. 2003/0109265) and in further view of Roel-Ng *et al.* (U.S. Patent No. 6,002,936); claims 6-9 stand rejected under 35 U.S.C. § 103(a) over the '698, '265 and '936 references and further in view of Ludwig (U.S. Patent No. 6,256,498); claims 10-11, 13, 15-17 and 22-23 stand rejected under 35 U.S.C. § 103(a) over the '698 reference in view of the '265 reference; claims 18-20 stand rejected under 35 U.S.C. § 103(a) over the '698 and '265 references in view of Yabe *et al.* (U.S. Patent Pub. 2003/0013458); and claim 21 stands rejected under 35 U.S.C. § 103(a) over the '698, '265 and '936 references in view of the '458 reference. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses each of rejections for lack of correspondence and for reliance upon an improper combination of references as discussed in more detail hereafter.

As applied to each of the rejections, Applicant submits that the alleged modification of the primary '698 reference with the teachings of the secondary '265 reference are illogical. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01 citing *In re Ratti*, 270 F.2d 810 (CCPA 1959). The principle operation taught by the primary '698 reference relates to a single portable terminal device that provides the relied upon interface and control for use with various applications. The '265 reference is directed toward a cellular communication system in which nearly all of the relied upon functionality is provided by remote servers and positioning centers (*see, e.g.*, Fig. 24 and the instant Office Action. pp. 4-5). The Office Action is relying upon a modification that would move the functions of the single portable terminal to one or more remote servers. Accordingly, the modification significantly changes the principle operation of the primary '698 reference and the

M.P.E.P. expressly prohibits the modification. Applicant respectfully requests that all of the rejections be withdrawn.

With particular regards to claim 1 and as applied to its dependent claims, the rejection fails to show correspondence to, in response to detecting a context change, ordering of the list of position determination devices using the context corresponding position determination device selection process and based upon one parameter for each position determination device. None of the cited references teaches such aspects, the alleged combination fails to correspond, and the only evidence of record that suggests such limitations is Applicant's specification.

For instance, Applicant disagrees with the Office Action's assertion that the primary '698 reference teaches ordering a list of devices according to a parameter of each device and in response to a detected context change. The cited portions of the primary '698 reference, instead, appear to teach that newly detected devices (*e.g.*, a car GPS) are simply added or removed from a list of all possible devices. The only time the Office Action has shown that another parameter is used is during a selection process (Fig. 4), which is taught to occur in response to a positioning request. The addition or removal of a device is therefore substantially independent of the determination of which device is "the best possible positioning method for each of the sequence of requests." '698 reference, para. 0053. Accordingly, the conclusion of the Office Action is inconsistent with the teachings of the '698 reference, which have not been shown to order a list of devices, based upon a parameter and in response to detecting a change in context information. Neither of the additionally-cited references have been alleged or shown to teach correspondences to such aspects.

Moreover, the alleged modification involves modifying the primary '698 reference to "prioritize measuring systems based on the quality conditions from a request as taught by Yamamoto *et al.*" Instant Office Action, p. 6. To the extent that the rejection relies upon prioritization of measuring systems "as taught by" the '265 reference, this prioritization is taught to be responsive to a request for positional information (*see, e.g.*, Fig. 24 and relevant discussion), and the identified "quality conditions" do not include information about whether a user is in transit, on foot or indoors.

For at least the aforementioned reasons, Applicant respectfully requests that the rejections be withdrawn.

With particular regards to claim 4, Applicant requests clarification and submits that the rejection is improper. The Office Action alleges that over-riding the selection process, as taught by the primary '698 reference, somehow corresponds to the claim limitations of claim 4. Applicant submits that this is erroneous. For instance, there is no evidence or assertion that this over-riding involves checking for an active position determination device. Since this checking step is not taught, it is illogical to assert that other steps conditional upon this check are taught therein. In particular, there is no evidence that if no active device is found, an ordered list will be used to select a device. The alleged correspondence is not founded in the actual teachings of the primary '698 reference, which appear to teach little more than the application is able to explicitly designate a device. Accordingly, Applicant submits that the rejection is improper and requests that it be withdrawn.

With particular regards to claim 10 and as applied to its dependent claims, Applicant respectfully submits that the Office Action's assertion that a "register" is a "driver" is not consistent with the plain meaning and the ordinary and customary use of these terms. "[T]he words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification....The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." M.P.E.P. § 2111.01 (citations omitted). Applicant submits that a common use of the term "register" is a hardware device capable of storing small amounts for data. A common use of the term driver, however, is a computer program allowing higher-level computer programs to interact with a hardware device. These uses also appear consistent with both Applicant's specification and the primary '698 reference. The Office Action presents no argument, explanation or evidence that would support deviating from the ordinary and customary use of the terms. Accordingly, Applicant submits that the rejections are improper and requests that they be withdrawn.

With particular regards to claim 13, Applicant submits that the Office Action does not address the claim limitations. The rejection misquotes the limitations as requiring "at

least one;" however the claim limitations require "at least two." The Office Action only alleges correspondence to one listed parameter, rendering the rejection *prima facie* invalid. Applicant respectfully requests that the rejection be withdrawn.

With particular regards to claims 22-23, Applicant submits that the Office Action fails to show correspondence to the claim limitations. The Office Action's assertion of correspondence is inconsistent with Applicant's specification. "Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim." M.P.E.P. § 2111.01. Applicant's specification (p. 11) clearly defines, by virtue of the Latin term "*i.e.*," synchronous as being "at predetermined times" and asynchronous as being "upon request from an application." It is unclear what definition the Office Action is proposing for the terms "synchronous" and "asynchronous;" however, it is clear that the cited aspects of the '698 reference are not consistent with these definitions provided in Applicant's specification. For instance, the cited paragraph 0052 teaches that the "continuous sequence" is a continuous sequence of positioning requests and parameters and that the "one-off" manner is a single positioning request and parameter. Accordingly, the '698 reference teaches that both the "continuous sequence" and the "one-off" manner operate by providing positional information in response to a request from an application. No correspondence is therefore present for position information being provided synchronously, *i.e.*, at predetermined times. Applicant submits that the rejection is improper and requests that it be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Schaeffer, of NXP Corporation at (212) 876-6170 (or the undersigned).

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